

### **REMARKS**

Favorable reconsideration is respectfully requested.

The claims are 1 to 8 with claims 3 to 5 being withdrawn from consideration.

The above amendment makes minor editorial revisions to the claims.

The objection to claim 7 is based on the assumption that the unit of "ares" is a typographical error for "acres". In reply, please make reference to a dictionary such as Webster's Third New International English Dictionary which clearly defines "are" as a unit of area standing for 100 m<sup>2</sup>. This unit is traditional and conventional in the agricultural field in Japan. The Applicants have no objection to converting the unit.

Claims 1, 2 and 6 to 8 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. (EP 1101760) in view of Auler et al. (WO 00/03592).

This rejection is respectfully traversed.

The rejection contends that it would have been obvious to combine pyrimisulfan (hereinafter compound A) and fentrazamide (hereinafter compound B) as a herbicide for paddy rice growing fields. The reasoning is that it would have been obvious to combine two compounds A and B each of which is known as a herbicide for paddy fields in preparing a new herbicide composition. This contention, however, is not based on the skill of the art familiar with the developmental history of herbicide compositions. The matter is not so simple as is assumed by the rejection.

An agrochemical developer seeking to develop novel herbicide compositions is required to develop a composition having characteristics such as low effective dose of application, low toxicity against the crops, workers and consumers, sustainability of the herbicidal effects, broad spectrum of applicable weeds and many other factors.

In many cases the desired improvements can be reached by way of an unpredictable synergism between two components. Since the number of the base or candidate components to be combined is so large, a quite large number of test runs must be repeated at a reasonable cost and time. This procedure is superficially routine as alleged by the rejection but in fact, it is not at all "routine" and requires a high level of skill and experience.

The above-mentioned synergism between the compound A and the compound B could better be understood by making reference to the results obtained in Test Example 1 described in the specification at pages 11 to 13.

For example, in Table 2 on page 13, a herbicide employing compound B alone as the herbicidally effective ingredient is almost ineffective against paddy field weeds other than early watergrass (Ec) while, when combined with compound A, provides a herbicidal composition effective against a broad spectrum of paddy field weeds including early watergrass (Ec) as a result of synergism with compound B.

Directing attention to the weed-controlling effect in Table 2 for tidalmarsh flatsedge (Cy) and URIKAWA (Sa), it can be said that, taking tidalmarsh flatsedge (Cy) as an example, it would not be obvious that a herbicidal effect of index 10 (95% or higher) could be obtained by combining the compound A having a herbicidal effect of index 6 (less than 65%) at a dose of 1 g/10a and index 8 (less than 85%) at a dose of 2 g/10a with the compound B which exhibits a herbicidal effect of only index 0 (5% or lower). That can be said in the case of URIKAWA (Sa) as well.

A vast number of tests must be repeated to uncover a particular compound capable of exhibiting synergism with the particular compound A if the choice of the compound B is carried out relying on so-called "routine" experimentation only.

One of ordinary skill in the agrochemical art would not be motivated to test the combination of the particular compound A and particular compound B from among the very

numerous kinds of the base compounds as a candidate for making a combination for the test of synergism before he could arrive at the presently claimed composition.

The holding of unobviousness is completely consistent with the USPTO guidelines in interpreting the recent Supreme Court decision *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q. 2d 1385 (2007).

In this regard, rationale (A) Fed. Reg. Vol. 72, No. 195, 57529 (2007) i.e. combining prior art elements according to known methods to yield predictable results is inapplicable since the results obtained herein are unpredictable i.e. synergism, as discussed above.

Further, rationale (E) "obvious to try" involves choosing from a finite number of identified predictable solutions with a reasonable expectation of success. However, as pointed out above, there is no reasonable expectation of success in the present case.

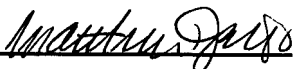
For the foregoing reasons, the rejection on prior art is untenable and should be withdrawn.

No further issues remaining, allowance of this application is respectfully requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact undersigned at the telephone number below.

Respectfully submitted,

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